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1 "Thus, a web page served by an HTTPd server system ... embeds a URL  
2 reference to a web page served by the logically external server system. Selection  
3 of this embedded URL through the client browser of the client computer system  
4 12 results initially in an HTTP transaction with the server system 16 rather than the  
5 external server." (Emphasis added by Examiner.) The Examiner then argues that  
6 the "selection of [the] embedded URL" *inherently* requires that the web page be  
7 displayed to the user. However, this is not the case. In fact, the "selection" of the  
8 embedded URL is performed **automatically** by the browser, as is clear from Col. 13  
9 lines 24-28 of Kirsch, which state, "Specifically, the embedded information  
10 controls the operation of the Web browser on the client computer system  
11 sufficient to issue a notification URL 98 directed to the redirection target server  
12 system 88, as shown in FIG. 5. **The server process 100 initiated in response to**  
13 **the notification URL receipt produces the redirection message** that is returned  
14 to the client computer system 80." (Emphasis added.) Accordingly, the web page  
15 84 (Fig. 5) which includes the user information is **not** inherently displayed to the  
16 user, since the "selection" recited in Col. 7 lines 10-17 is performed by the **web**  
17 **browser**, and not by the user. This position is further supported by Figs. 6 and 7 of  
18 Kirsch, which only show a single banner click which then causes the process  
19 depicted in Fig. 5 to be performed. That is, if the "selection" referred to in Col. 7 lines  
20 10-17 were performed by the user, then the processes depicted in Figs. 6 and 7 of  
21 Kirsch would show a second banner click, which they do not.

22 Notwithstanding, the Applicants have amended claims 22, 30, and 42 to recite  
23 (in slightly varying language) that "the web page files ... include[ ] user information  
24 associated with the web user's use of the web tool ... [and] wherein **the web page**  
25 **files correspond to desired information to be received and viewed by the user.**"  
(Emphasis added.) That is, it is now clear from claims 22, 30 and 42 that the web  
page files that include the user information are also the web page files that the user

1 desires to receive and view. Support for this amendment is found in the specification  
2 at page 7 first paragraph, which states in part: "Within the session, the user transmits  
3 to a web tool server requests for receiving and viewing **desired information**. Upon  
4 receiving a request, the web tool server through its executing web tool 113  
5 generates and transmits to the user's browser a responsive **web page file**  
6 **containing the desired information.**" (Emphasis added.)

7 Accordingly, **even if it is true that Kirsch displays to the user the web**  
8 **page that includes the user information (i.e., web page 84 of Fig. 5), then it is**  
9 **clear that this web page (84) is not the web page that "correspond[s] to desired**  
10 **information to be received and viewed by the user"**. That is, the web page in  
11 Kirsch that corresponds to "desired information to be received and viewed by the  
12 user" is web page 92 (Fig. 5), which does not contain any user information – it is only  
13 web page 84 that contains the user information. As stated in Kirsch's own words,  
14 "Indeed, as evident to the user of the client computer 80, *the only response*  
15 *recognized as significant is the receipt 116 of the Web page 92.*" (Kirsch, Col. 13,  
16 lines 61-64; emphasis added.) That is, the content desired by the user is web page  
17 92, not web page 84. Put another way, web page 84 includes the user information  
18 that is to be tracked, but it does not include the page content desired by, and to be  
19 displayed to, the user.

20 The Applicants respectfully request that the Examiner review the annotated  
21 copy of Kirsch's Fig. 5 that was provided with the last response, and the accompany  
22 description at Col. 12 of Kirsch. It will be evident from Fig. 5, and the accompanying  
23 description, that Kirsch's method is substantially different than the Applicants'  
24 claimed method. Further, it should be noted that the description at Col. 7 of Kirsch  
25 that the Examiner relies on accompanies Fig. 1 of Kirsch, and as can be seen, Fig. 1  
is merely a figure showing equipment components of a generic Internet-based  
client/server system – there are no data flow or data processing steps shown.

1 Accordingly, Fig. 1, and the accompanying description at Col. 7, are not specific, and  
2 cannot be considered as actually describing any process disclosed by Kirsch.

3 For at least these reasons, the Applicants contend that claims 22, 30, and 42,  
4 and those claims which depend therefrom, are now patentable over Kirsch, since  
5 they contain a limitation not found in Kirsch (i.e., the limitation that the web page that  
6 is transmitted to the user, and which includes the user information, is also the web  
7 page that contains the information desired to be viewed by the user). Accordingly,  
8 the Applicants request that the rejection of claims 22-25, 29-30, 36-38 and 42 as  
9 being anticipated by Kirsch be removed and that the claims be allowed.

#### 11 Rejection of Claims under 35 U.S.C. § 103(a)

12 Claims 26-27, 31-35, 39 and 41 have been rejected under 35 U.S.C. § 103 as  
13 being obvious over U.S. Patent No. 6,466,966 B1 ("Kirsch") in view of U.S. Published  
14 Application US 2003/0220998 A1 to Jennings III et al. ("Jennings").

15 The Applicants contend that claims 26-27, 31-35, 39 and 41 are not obvious  
16 over Kirsch in view of Jennings.

17 The requirements to maintain a 103 rejection have been set forth in the  
18 previous response. In brief, MPEP 706.02(j) states, "[t]o establish a *prima facie* case  
19 of obviousness, ... the prior art reference (or references when combined) **must**  
20 teach or suggest **all** the claim limitations." (Emphasis added.)

21 In the previous response the Applicants argued that neither Kirsch nor  
22 Jennings taught or suggested the use of a "BIT" tag that, when executed by the user  
23 computer, causes user information to be sent to a designated server. In that  
24 response, the Applicants explained what the term "BIT tag" means ("BIT" being an  
25 acronym for "Broken Image Tracking"), where support for the expression "BIT tag" is  
found in the specification, and why the references do not show the use of a BIT tag,  
as that term is used by the Applicants in their claims. In response, the Examiner

1 appears to take the position that the Applicants have argued limitations not found in  
2 the claims. The Examiner states that, "Although the claims are interpreted in light of  
3 the specification, limitations from the specification are not read into the claims."

4 The Applicants respectfully contend that they have not argued limitations not  
5 found in the claims, but have merely presented arguments as to why the cited  
6 references do not show the claimed features. It is well known that a patent  
7 draftsman is entitled to be his or her own lexicographer, and to define terms, so  
8 long as those terms are not repugnant to the common usage of the language. Here,  
9 the Applicants have defined in the specification the term "BIT tag", and have then  
10 used that term in the claims. Specifically, the first paragraph of page 4 of the  
11 specification recites:

12  
13 The present invention provides and employs the use of Broken  
14 Image Tracking ("BIT") for tracking user information for users of a web  
15 site or web tool. With BIT, the web page generating program (e.g., a  
16 web tool program) inserts a "broken image" tag in various (or even all) of  
17 the web pages transmitted to a user. In general, a BIT tag is a HTML  
18 image tag (or equivalent) with a BIT URL, i.e., a URL that includes  
19 embedded user information and a broken image file designator. As used  
20 herein, a broken image file is a file that cannot be located, e.g., because  
21 it does not exist or because its directory path does not point to it. The  
22 BIT URL has a file path that directs the user's image-retrieving browser  
23 to an information gathering ("broken image") web server. With the  
24 designated broken image file in the URL, the broken image server will  
25 attempt but will not be able to find and retrieve to the browser the broken  
image file. This causes the server to log (in its error log) the BIT URL,  
which includes the user information. In this way, user information can be

1 collected and routed into a centralized repository such as the error log  
2 within the broken image server.

3  
4 Since the term "BIT tag" is thus well defined in the specification by the  
5 Applicants, the use of that term in the claims is entirely acceptable, and inherently  
6 includes the full scope of the term as defined in the specification. The Applicants  
7 should not be required to insert into the claims the complete definition of a term that  
8 is provided in the specification. To require otherwise would be contrary to the long  
9 held tenant that a patent draftsman is entitled to be his or her own lexicographer.  
10 Furthermore, the use of the term "BIT tag" is not repugnant to any ordinary use of the  
11 term.

12 The Applicants note that the Examiner has not argued that Kirsch and  
13 Jennings show the use of a "BIT tag", as that term is defined by the Applicants in the  
14 specification, but only that the Applicants have apparently argued limitations not set  
15 forth in the claims. However, since the term "BIT tag" is well defined in the  
16 specification, and the references do not show an equivalent component, the  
17 Applicants contend that the rejected claims are, in fact, allowable over Kirsch in view  
18 of Jennings.

19 For at least this reason, the Applicants contend that claims 26-27, 31-35, 39  
20 and 41 are not obvious over Kirsch in view of Jennings. The Applicants therefore  
21 request that the rejection of these claims be removed and the claims allowed.

22 Further, with respect to independent claim 39, and claims 40 and 41 which  
23 depend therefrom, claim 39 has been included to include the limitation that "the web  
24 page files [which include the user information] correspond to desired information to  
25 be received and viewed by the user". This amendment is essentially the same  
amendment as was made to claims 22, 30 and 42, and was discussed above.  
Accordingly, claim 39 (and inherently, claims 40 and 41 which depend therefrom)

1 now include a limitation neither taught nor suggested by the prior art, and should  
2 therefore be allowed.

3  
4 For at least all of reasons stated above, the Applicants contend that none of  
5 rejected claims 22-27, 29-39, 41, and 42 (as respectively amended) are anticipated  
6 by Kirsch, or are obvious over Kirsch in view of Jennings. The Applicants therefore  
7 respectfully request timely allowance of claims 22-42.

8  
9 Summary

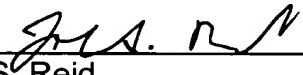
10 The Applicants believe that this response constitutes a full and complete  
11 response to the Office action, and therefore request timely allowance of all claims 22  
12 through 42.

13 The Examiner is respectfully requested to contact the below-signed  
14 representative if the Examiner believes this will facilitate prosecution toward  
15 allowance of the claims.

16  
17 Respectfully submitted,

18 Matthew B. Parrish and Jerry B. Decime

19  
20 Date: August 13, 2004

21 By   
22 John S. Reid  
23 Attorney and agent for Applicants  
24 Reg. No. 36,369  
25 Phone: (509) 534-5789